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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,801	09/10/2003	Paolo Gatti	PC23575A	1817
28940	7590	11/01/2006	EXAMINER	
PFIZER INC 10555 SCIENCE CENTER DRIVE SAN DIEGO, CA 92121				STITZEL, DAVID PAUL
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/658,801	GATTI, PAOLO
	Examiner	Art Unit
	David P. Stitzel, Esq.	1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 August 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 107-119 is/are pending in the application.
- 4a) Of the above claim(s) 1-106 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 107-119 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

OFFICIAL ACTION

Acknowledgment of Receipt

Receipt of the Applicant's Response, which was filed on August 8, 2006, in response to the Official Action dated April 7, 2006, is acknowledged.

Status of Claims

Claims 1-106 were canceled, and claims 107-119 were added by an amendment that accompanied the aforementioned Response. As a result, claims 107-119 are currently pending and therefore examined herein on the merits for patentability.

Claim Rejections - 35 U.S.C. § 102

The following are quotations of the appropriate paragraphs of 35 U.S.C. § 102, which form the basis of the anticipation rejections as set forth under this particular section of the Official Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. The rejection of claims 1, 2, 4, 8-16, 18-43, 45-56, 59, 61-77 and 92 under 35 U.S.C. § 102(b) as being anticipated by the Shenoy '820 publication is hereby withdrawn as being moot in view of the cancellation of said claims.

2. The rejection of claims 1, 2, 4, 8-16, 18-43, 45-56, 59, 61-77, 79, 80, 83-85, 87 and 92 under 35 U.S.C. § 102(e) as being anticipated by the O'Farrell '280 publication is hereby withdrawn as being moot in view of the cancellation of said claims.

3. Claims 107-119 are rejected under 35 U.S.C. § 102(b) as being anticipated by International Application Publication WO01/37820 (hereinafter the Shenoy '820 publication).

With respect to claims 107-112, 118 and 119 of the instant application, the Shenoy '820 publication discloses a solid formulation comprising: a malate salt of 5-(5-fluoro-2-oxo-1,2-dihydro-indol-3-ylidenemethyl)-2,4-dimethyl-1H-pyrrole-3-carboxylic acid (2-diethylaminoethyl)amide present in an amount from about 0.01 % by weight to about 90 % by weight; wherein said solid formulation may further comprise: mannitol as a diluent, which is present in an amount from about 10 % by weight to about 80 % by weight; polyvinylpyrrolidone as a binder, which is present in an amount from about 2 % by weight to about 20 % by weight; croscarmellose sodium (a.k.a., crosslinked sodium carboxymethylcellulose) as a disintegrant, which is present in an amount from about 2 % by weight to about 20 % by weight; and magnesium stearate as a lubricant, which is present in an amount from about 1 % by weight to about 2 % by weight (page 14, lines 4-5; page 29, line 5; page 39, compound 80; page 60, lines 1-8; page 61, lines 14-28; page 64, lines 9-11; page 65, lines 1-4; page 72, lines 18-31; page 73, lines 1-31; page 76, lines 1-3; page 82, lines 24-25 and 28-30; page 84, lines 8-9, 12-13 and 26; page 92, lines 8-30; page 93, lines 1-4; page 96, lines 5-29; page 158, lines 28-30; page 159, lines 1-8; page 233, lines 6-10; and claims 11, 50, 52-54 and 56).

With respect to claim 113 of the instant application, the Shenoy '820 publication discloses a solid formulation that may, but need not necessarily, further comprise: a surfactant present in an amount ranging from 0 wt. % to 50 wt. % (page 92, Table); and a flow enhancer present in an amount ranging from 0 wt. % to 1 wt. % (page 93, Table continued).

With respect to claims 114-117 of the instant application, absent a showing to the contrary, since the Shenoy '820 publication discloses a solid formulation that is identical to the solid formulation as instantly claimed, the prior art composition inherently possesses physicochemical properties (i.e., bulk density and particle sizes) that are identical to those claimed in claims 114-117. As a result, the Shenoy '820 publication anticipates said claims.

As a practical matter, the USPTO is not equipped with the scientific laboratory instrumentation and facilities necessary for the manufacture of the myriad of claimed products set forth before it and then obtain requisite prior art products so as to conduct side-by-side analytical comparisons of the physicochemical properties inherently associated therewith. See *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). The "discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." See *Atlas Powder Co. v. Ireco Inc.*, 51 USPQ 2d 1943, 1947 (Fed. Cir. 1999). Therefore, merely claiming a new use, new function or unknown property, which is inherently present in the prior art, does not necessarily make the claim patentable. See *In re Best*, 195 USPQ 430, 433 (CCPA 1977); and MPEP § 2112. Furthermore "products of identical chemical composition can not have mutually exclusive properties," since a chemical composition and its properties are inseparable. See *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); and MPEP § 2112. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. See MPEP § 2112.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 103, which forms the basis of the obviousness rejections as set forth under this particular section of the Official Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. The rejection of claims 79-85 and 87 under 35 U.S.C. § 103(a) as being unpatentable over the Shenoy '820 publication is hereby withdrawn as being moot in view of the cancellation of said claims.
2. The rejection of claims 81 and 82 under 35 U.S.C. § 103(a) as being unpatentable over the O'Farrell '280 publication is hereby withdrawn as being moot in view of the cancellation of said claims.
3. The rejection of claims 1, 2, 4, 8-11, 68-77 and 92 under 35 U.S.C. § 103(a) as being unpatentable over the Lipson '689 publication is hereby withdrawn as being moot in view of the cancellation of said claims.

4. The rejection of claims 1, 2, 4, 8-11, 68-77 and 92 under 35 U.S.C. § 103(a) as being unpatentable over the Hawley '298 publication is hereby withdrawn as being moot in view of the cancellation of said claims.

5. The rejection of claims 1, 2, 4, 8-11, 68-77 and 92 under 35 U.S.C. § 103(a) as being unpatentable over the Tang '292 publication is hereby withdrawn as being moot in view of the cancellation of said claims.

6. Claim 117 is rejected under 35 U.S.C. § 103(a) as being unpatentable over International Application Publication WO01/37820 (hereinafter the Shenoy '820 publication) in view of U.S. Pre-Grant Patent Application Publication 2003/0069298 (hereinafter the Hawley '298 publication).

The teachings of the Shenoy '820 publication are incorporated herein by reference and are therefore applied in the instant rejection as discussed hereinabove.

With respect to claim 117 of the instant application, the Shenoy '820 publication does not explicitly teach that said solid formulation is in particulate form, wherein no more than 55% of said particles have a particle size of less than 250 microns in diameter.

However, the Hawley '298 publication teaches a solid formulation comprising: an L-malate salt of 5-(5-fluoro-2-oxo-1,2-dihydro-indol-3-ylidenemethyl)-2,4-dimethyl-1H-pyrrole-3-carboxylic acid (2-diethylaminoethyl)amide ([0006], [0007], [0027]; claims 1 and 2); wherein said solid formulation may further comprise: mannitol; polyvinylpyrrolidone; croscarmellose sodium (a.k.a., crosslinked sodium carboxymethylcellulose); and magnesium stearate ([0067]-

[0069]); wherein the L-malate salt of 5-(5-fluoro-2-oxo-1,2-dihydro-indol-3-ylidenemethyl)-2,4-dimethyl-1H-pyrrole-3-carboxylic acid (2-diethylaminoethyl)amide is preferably crystallized as large particles, which is desirable in large scale manufacturing operations, so as to facilitate filtration processes ([0028]).

Although the Hawley '298 publication teaches utilizing larger sized particles of the L-malate salt of 5-(5-fluoro-2-oxo-1,2-dihydro-indol-3-ylidenemethyl)-2,4-dimethyl-1H-pyrrole-3-carboxylic acid (2-diethylaminoethyl)amide ([0028]), the Hawley '298 publication fails to explicitly teach that said solid formulation is in particulate form, wherein no more than 55% of said particles have a particle size of less than 250 microns in diameter, as claimed in claim 117. However, while the Hawley '298 publication does not explicitly teach the instantly claimed particle sizes of said solid formulation, it is well within the purview of the skilled artesian to determine the optimal particle sizes of said solid formulation by systematically adjusting the particle sizes thereof during the course of routine experimentation. One of ordinary skill in the art at the time the instant application was filed would have been motivated to systematically adjust the particle sizes of said solid formulation during the course of routine experimentation so to obtain a solid formulation having particle sizes that facilitate filtration processes during large scale manufacturing processes, as reasonably suggested by the Hawley '298 publication ([0028]). "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955). "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed

set of percentage ranges is the optimum combination of percentages.” See *Peterson*, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003).

Examiner’s Response to Applicant’s Remarks

In regard to the Applicant’s arguments as set forth in the aforementioned Response, they have been fully considered in light of the claims as currently amended and are persuasive with respect to the rejection based on the O’Farrell ‘280 publication, but are not persuasive with respect to the rejection based on the Shenoy ‘820 publication. Applicant’s cancellation of claims 1-106 and the addition of claims 107-119 necessitated the new grounds of rejection as set forth hereinabove.

1. 35 U.S.C. § 102(b) rejection of claims 1, 2, 4, 8-16, 18-43, 45-56, 59, 61-77 and 92 based on the Shenoy ‘820 publication.

Applicant argues on page 4 of the aforementioned Response, that the Shenoy ‘820 publication does not disclose formulations of the L-malate salt of 5-(5-fluoro-2-oxo-1,2-dihydro-indol-3-ylidenemethyl)-2,4-dimethyl-1H-pyrrole-3-carboxylic acid (2-diethylaminoethyl)amide and therefore the Shenoy ‘820 publication does not anticipate the claims as currently amended. In response to Applicant’s arguments, the Shenoy ‘820 publication discloses 5-(5-fluoro-2-oxo-1,2-dihydro-indol-3-ylidenemethyl)-2,4-dimethyl-1H-pyrrole-3-carboxylic acid (2-diethylaminoethyl)amide and a pharmaceutically acceptable malate salt thereof, which can be obtained by reacting said indolinone with an organic acid, such as malic acid (page 14, lines 4-5; page 29, line 5; page 39, compound 80; page 60, lines 1-8; page 64, lines 9-11; page 65, lines 1-4; page 76, lines 1-3). L-malate is the levorotatory, as opposed to the dextrorotatory, form or

enantiomer of a salt, or an ester, of malic acid. Although the Shenoy '820 publication does not explicitly teach the "levorotatory form" or the "levorotatory enantiomer" of malate (a.k.a., "L-malate") per se, the generic term malate inherently comprehends such a limited number (i.e., only two or a pair) of enantiomers, namely the levorotatory dextrorotatory enantiomers of malate, that the generic disclosure of "malate" inherently anticipates the species of L-malate and D-malate. See e.g., *Bigham v. Godtfredsen*, 857 F.2d 1415, 1417, 8 USPQ2d 1266, 1268 (Fed. Cir. 1988) ("[t]he generic term halogen comprehends a limited number of species, and ordinarily constitutes a sufficient written description of the common halogen species," except where the halogen species are patentably distinct).

2. 35 U.S.C. § 102(e) rejection of claims 1, 2, 4, 8-16, 18-43, 45-56, 59, 61-77, 79, 80, 83-85, 87 and 92 based on the O'Farrell '280 publication.

Applicant argues on pages 4 and 5 of the aforementioned Response, that in regard to the O'Farrell '280 publication, the non-provisional utility application (10/281,266, which was filed on October 28, 2002), but not the provisional application (60/330,623, which was filed on October 26, 2001) to which said non-provisional utility application claims priority, discloses formulations (Tables 1-3 in paragraphs [0203]-[0205]) having the concentration ranges as instantly claimed, and thus only the benefit of the filing date of the non-provisional utility application can be relied upon for an anticipatory rejection with respect to said concentration ranges. In response to Applicant's arguments, since Applicant's instant non-provisional utility application (10/658,801, which was filed on September 10, 2003) claims the benefit of provisional application (60/421,133, which was filed on September 10, 2002), wherein said

provisional application provides a written description of formulations having the instantly claimed concentration ranges, the Examiner is in agreement that the O'Farrell '280 publication does not anticipate the formulations having the instantly claimed concentration ranges.

3. Although Applicant's arguments have been considered with respect to the withdrawn rejection of claims 79-85 and 87 under 35 U.S.C. § 103(a) as being unpatentable over the Shenoy '820 publication, they are moot in view of the cancellation of said claims.

4. Although Applicant's arguments have been considered with respect to the withdrawn rejection of claims 81 and 82 under 35 U.S.C. § 103(a) as being unpatentable over the O'Farrell '280 publication, they are moot in view of the cancellation of said claims.

5. Although Applicant's arguments have been considered with respect to the withdrawn rejection of claims 1, 2, 4, 8-11, 68-77 and 92 under 35 U.S.C. § 103(a) as being unpatentable over the Lipson '689 publication, they are moot in view of the cancellation of said claims.

6. Although Applicant's arguments have been considered with respect to the withdrawn rejection of claims 1, 2, 4, 8-11, 68-77 and 92 under 35 U.S.C. § 103(a) as being unpatentable over the Hawley '298 publication, they are moot in view of the cancellation of said claims.

7. Although Applicant's arguments have been considered with respect to the withdrawn rejection of claims 1, 2, 4, 8-11, 68-77 and 92 under 35 U.S.C. § 103(a) as being unpatentable over the Tang '292 publication, they are moot in view of the cancellation of said claims.

Conclusion

Applicant's cancellation of claims 1-106 and the addition of claims 107-119 necessitated the new grounds of rejection presented in this Official Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to David P. Stitzel, M.S., Esq., whose telephone number is 571-272-8508. The Examiner can normally be reached on Monday-Friday, from 7:30AM-6:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Johann Richter, Ph.D., Esq., can be reached at 571-272-0646. The central fax number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published patent applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished patent applications is only available through Private PAIR. For more information about the PAIR system, please see <http://pair-direct.uspto.gov>. Should you have questions about acquiring access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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